

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group Art Unit 2444 :
Examiner Muktesh G. Gupta :
In re application of : METHOD FOR TRANSPARENTLY
WERNER LINDEMANN ET AL. EXCHANGING DATA PACKETS
Serial No. 10/529,334 :
Filed March 24, 2005 :
Confirmation No. 8888 :

REPLY BRIEF

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Date: December 13, 2010

Applicants hereby respond to the Examiner's Answer that was mailed on October 27, 2010.

1. The Examiner Admits That The Material In The Adcox et al. Reference That Is Relied Upon Is Not Disclosed In The Adcox et al. Provisional Application

The Examiner does not cite to any portion of the Adcox et al. provisional application to support the rejection of the pending claims. Instead, the Examiner contends that he reviewed the provisional and believes that the drawing and one page of content in the Adcox et al. provisional application sufficiently supports the material in the Adcox et al. published patent application, which names numerous new inventors and contains numerous new pages of content. (Examiner's Answer, at 29 and 36).

The factual finding made by the Examiner during prosecution shifts the burden onto Applicants to show that the Examiner has not sustained his burden of proof. *Ex parte Yamaguchi*, 88 USPQ2d 1606, 1608 and 1614 (BPAI 2008) (precedential). In the present case, Applicants easily meet this burden. *See Ex Parte Clifford A. Megerieie and Duane Lee Lindner*, 2010 WL 2127303 (BPAI 2010).

All of the material upon which the Examiner relies that is disclosed in the Adcox et al. published patent application is new matter that is not disclosed in the initial provisional application. This new matter is not supported in the Adcox provisional application. *See e.g., Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1302-03 (Fed.Cir.1999) ("Subject matter that arises for the first time in [a] CIP application does not receive the benefit of the filing date of the parent application.").

The Examiner explains his reliance on the Adcox provisional application by merely stating that he considered the provisional application in making his rejection. (Examiner's

Answer, at 36). However, the Examiner cannot identify where the limitations of the pending claims are disclosed or supported in the Adcox provisional application.

He cannot identify such portions because they are not present in the provisional application. For example, paragraphs 12, 13, 32, 49, 56-59, 61, 74-78, 86-88, 90-91, 96, 105-106, and 110-120 are all new to the Adcox et al. published patent application and have no support in the provisional application. Similarly, the Figures upon which the Examiner relies are new matter present for the first time in the Adcox et al. published patent application.

There is no support in this provisional application, U.S. Provisional Patent Application No. 60/374,690, for any of the material upon which the Examiner relies for rejecting the pending claims. In view of the non-existent detail provided in the provisional application, it is clear that Adcox et al. is not prior art to the claimed invention. The Examiner has admitted as much by failing to provide any citation to any portion of this provisional patent application that supports or otherwise corroborates his disputed finding. The Examiner's failure to provide any rationale for why he finds support in the provisional application is also an admission that all of the information upon which the Examiner relies is new matter that is disclosed for the first time in the Adcox et al. published patent application.

The Adcox et al. reference and the provisional application to which it claims priority fail to provide sufficient support to the Examiner for rejecting the claims under 35 U.S.C. §§ 102 or 103. The pending claims are allowable over the cited art.

2. All Of the Adcox et al. Paragraphs And Figures Relied Upon By The Examiner Are New Matter When Compared To The Adcox Provisional Application, U.S. Provisional Patent Application No. 60/374,690

The Examiner has failed to cite to any portion of the provisional patent application to support his rejection of the pending claims. Moreover, every paragraph and Figure in the Adcox

et al. published patent application upon which the Examiner relies is new matter to the provisional application. None of this information was set forth in the provisional application. It is not supported therein.

3. Nevertheless, Applicants' Arguments For Patentability Do Not Only Rely On The Fact That The Adcox Provisional Application Fails To Provide Adequate Support For The Examiner's Rejections Of The Pending Claims

Adcox et al. do not teach or suggest any unique address of the first network element that is valid for the external device being transferred to the external device without converting that address for the duration of the temporarily transparent connection, which is a limitation in all of the pending claims on appeal. To fact, Adcox et al. teach that all outgoing messages to external devices are replaced with a different address. (Adcox et al. at Abstract; *see also id.* at ¶¶ 118-19).

As may be appreciated from the provisional application to which the Adcox et al. reference claims priority, Adcox et al. teach a system that is configured so that "a MAC layer address translation (MAT)" occurs. "Outgoing packets will have their source MAC address replaced with the altered OEC MAC address. Incoming packets will be sensed by the destination OEC and the serial portions will be used by the OEC to replace the destination MAC with the host pointed to in the MAC table." (U.S. Provisional Patent Application No. 60/374,690, at page 1, last paragraph). As another example, the Adcox et al. reference teaches that a MAC address table 420 is used to translate a secondary HNU MAC address into a secure MAC layer address to transmit data packets for outgoing messages being transmitted to an external device. (Adcox et al., ¶ 120).

Adcox et al. teach a system that requires an address to be changed, or translated, every time data packets are transmitted from an external device to a network element. Adcox et al.

expressly teach away from the pending claims, which require a unique address of a network element that is valid for an external device to not be changed during a duration of a temporarily transparent connection. Indeed, Adcox et al. does not teach any transparent connection as required by the pending claims.

CONCLUSION

For at least the above reasons, reversal of the rejection of claims 14-35 and allowance of these claims are respectfully requested.

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Respectfully submitted,

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